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08/876,937

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/876,937	06/16/97	WOODWARD	16955DIVCONC

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HM22/0302

EXAMINER	
D SULLIVAN, P	
ART UNIT	PAPER NUMBER
1621	11

DATE MAILED: 03/02/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10 September 1998 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), - days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 26-45 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 26-45 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.35 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

P. O. Sullivan

PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200

EXAMINER'S ACTION

BEST AVAILABLE COPY

Art Unit: 1209

1. Claims 26-45 are pending in this application. The rejection of the claims under 35 U.S.C. 135(b) is withdrawn in view of applicants' arguments.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 26, 28-34 and 36-45 are again rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' arguments have been given due consideration, but are found non-persuasive. The group R1 is broader than that shown in the specification in each case as originally filed. Applicants' "pharmaceutically acceptable ester moiety" could contain an aryl group in the alcohol moiety which is not enabled in the specification. Other claims which depend from rejected generic claims, but do not further limit R1 to the scope originally in the specification are rejected as well.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 1209

5. Claims 26-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Bishop '383. Applicants' arguments have been given due consideration, but are found non-persuasive. Contra applicants' arguments, the disclosure of '567 is seen to be narrower than the present claims as discussed above. Contra applicants' arguments at the middle of page three of their amendment, under 35 U.S.C. 102(e), consideration of the filing date of Bishop, not the date of issue, is made in the rejection. Applicants' declaration is not seen to render any present claim allowable.

6. The following allowable claim is suggested for the purpose of an interference: --

A method of treating glaucoma and ocular hypertension which comprises topically administering to the affected eye a therapeutically effective amount of heptenamide-5-cis-2(3- hydroxy-4-m-chlorophenoxy-1-trans-butenyl)-3,5 dihydroxy [1α , 2β , 3α , 5α] cyclopentane. --

The suggested claim must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

Applicant should make the suggested claim within ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer. Failure to do so will be considered a disclaimer of the subject matter of this claim under the provisions of 37 CFR 1.605(a). THE PROVISIONS OF 37 CFR 1.136(a) DO NOT APPLY TO THIS TIME PERIOD.

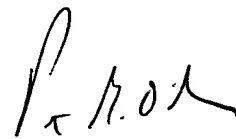
7. Applicants are further requested to make a declaration under 37 C.F.R. 1.608(b) with to the above compound.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1209

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to Peter O'Sullivan at telephone number (703) 308-4526.



PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200